



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/803,856

03/18/2004

Jeffrey S. Poulin

L0562.70049US00

6542

23628 7590 08/16/2007  
WOLF GREENFIELD & SACKS, P.C.  
600 ATLANTIC AVENUE  
BOSTON, MA 02210-2206

EXAMINER

ERB, NATHAN

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

08/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/803,856

Applicant(s)

POULIN, JEFFREY S.

Examiner

Nathan Erb

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 16, 2007, has been entered.

### ***Response to Arguments***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. In response to applicant's amendments and arguments, the rejections of the claims have been correspondingly modified below in this Office action. It is believed that the amended rejections render applicant's arguments no longer valid.

### ***Claim Rejections - 35 USC § 102***

4. Claims 1-9, 11-19, 21-24, and 26-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Pintsov et al., U.S. Patent No. 6,775,590 B2.

As per **Claims 1, 11, and 21**, Pintsov et al. discloses:

- a method of processing business reply mail using a sorting apparatus, comprising acts (column 1, lines 6-10; column 8, lines 10-45; column 9, lines 4-36; apparatus processes business reply mail pieces; apparatus may be integrated into a facer/canceller system which can separate out business reply mail and courtesy reply mail);

Art Unit: 3628

- receiving (or at least one feeder unit that receives) a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece (Figure 4; column 8, lines 10-45; column 9, lines 4-36; column 9, lines 37-52; apparatus may be integrated into a facer/canceller system which can separate out business reply mail and courtesy reply mail, as opposed to the apparatus receiving a stream of only business reply mail and courtesy reply mail from an upstream facer/canceller system; where the apparatus is integrated into the facer/canceller system, the input stream of mail pieces can contain both business reply and non-business reply mail pieces);

- automatically identifying the at least one business reply mail piece in the stream of mail pieces (column 3, line 26, through column 4, line 28; column 8, lines 10-45; column 9, lines 4-36; column 9, lines 37-52; claims 17, 25, and 32; apparatus may be integrated into a facer/canceller system which can separate out business reply mail and courtesy reply mail, as opposed to the apparatus receiving a stream of only business reply mail and courtesy reply mail from an upstream facer/canceller system; where the apparatus is integrated into the facer/canceller system, the input stream of mail pieces can contain both business reply and non-business reply mail pieces; the apparatus identifies a business reply mail piece from data read from the mail piece; identifying here could also be interpreting that the mail piece is in front of the scanner and ready to be read);

- determining that the at least one business reply mail is a business reply mail piece and not a non-business reply mail piece (column 3, line 26, through column 4, line 28; column 8, lines 10-45; column 9, lines 4-36; column 9, lines 37-52; apparatus may be integrated into a facer/canceller system which can separate out business reply mail and courtesy reply mail, as

Art Unit: 3628

opposed to the apparatus receiving a stream of only business reply mail and courtesy reply mail from an upstream facer/canceller system; where the apparatus is integrated into the facer/canceller system, the input stream of mail pieces can contain both business reply and non-business reply mail pieces; the apparatus determines that a mail piece is a business reply mail piece when it detects the MRCI on the mail piece);

- in response to the act of determining that the at least one business reply mail piece is a business reply mail piece, automatically reading information on the at least one business reply mail piece while the at least one business reply mail piece is in the stream of mail pieces (column 3, line 26, through column 4, line 28; column 8, lines 10-45; column 9, lines 4-36; column 9, lines 37-52; apparatus may be integrated into a facer/canceller system which can separate out business reply mail and courtesy reply mail, as opposed to the apparatus receiving a stream of only business reply mail and courtesy reply mail from an upstream facer/canceller system; where the apparatus is integrated into the facer/canceller system, the input stream of mail pieces can contain both business reply and non-business reply mail pieces; the apparatus reads the MRCI on the mail piece);

- at least one computer readable medium encoded with instructions that, when executed on a computer system perform a method of processing business reply mail, the method comprising acts (column 1, lines 6-10; column 11, lines 21-34; software must be stored on some sort of computer readable medium);

- a sorting apparatus (column 8, lines 10-45; column 9, lines 4-36; apparatus may be integrated into a facer/canceller system which can separate out business reply mail and courtesy reply mail);

- at least one controller (Figure 4).

As per **Claims 2, 12, and 22**, Pintsov et al. further discloses wherein the act of automatically identifying the business reply mail piece further comprises an act of: distinguishing the at least one business reply mail piece from the at least one non-business reply mail piece (column 3, line 26, through column 4, line 28; column 8, lines 10-45; column 9, lines 4-36; column 9, lines 37-52).

As per **Claims 3, 13, and 23**, Pintsov et al. further discloses wherein the act of automatically reading information on the at least one business reply mail piece further comprises acts of: (at least one camera) capturing at least one image of the at least one business reply mail piece; and processing the at least one image to convert the information on the at least one business reply mail piece into electronic form (column 11, line 60, through column 12, line 27; column 12, lines 36-52).

As per **Claims 4, 14, and 24**, Pintsov et al. further discloses wherein the act of automatically reading information on the at least one business reply mail piece further comprises an act of: (a barcode reader) reading a barcode on the at least one business reply mail piece (column 3, line 26, through column 4, line 28; column 6, lines 14-32).

As per **Claims 5 and 15**, Pintsov et al. further discloses wherein the at least one business reply mail piece is addressed to an intended recipient and the method further comprises an act of:

Art Unit: 3628

discarding the at least one business reply mail piece without delivering the at least one business reply piece to the intended recipient (column 12, lines 36-52).

As per **Claims 6, 16, and 26**, Pintsov et al. further discloses an act of: storing the information in electronic form (column 11, line 60, through column 12, line 27; column 12, lines 36-52).

As per **Claims 7, 17, and 27**, Pintsov et al. further discloses wherein the business reply mail piece is associated with an originating entity and the method further comprises an act of: receiving the information at (or sending the information to) the originating entity (column 11, line 60, through column 12, line 27).

As per **Claims 8, 18, and 28**, Pintsov et al. further discloses wherein the act of sending the information to the originating entity further comprises an act of sending the information to the originating entity in electronic form (column 11, line 60, through column 12, line 27).

As per **Claims 9, 19, and 30**, Pintsov et al. further discloses wherein the acts of receiving, automatically identifying, and automatically reading are performed at a mail processing facility (column 3, line 26, through column 4, line 28; column 8, lines 10-45; column 9, lines 4-36; column 9, lines 37-52; claims 17, 25, and 32).

As per **Claim 29**, Pintsov et al. further discloses wherein the business reply mail piece is associated with an originating entity and the at least one controller receives a request for the information from the originating entity (Figure 4; column 6, lines 33-67; column 11, line 60, through column 12, line 27).

As per **Claim 31**, Pintsov et al. further discloses wherein the information includes an address of an initial recipient of the business reply mail piece (column 6, lines 33-67).

***Claim Rejections - 35 USC § 103***

5. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pintsov et al. in view of Gleckman, U.S. Patent Application Publication No. US 2004/0215472 A1.

As per **Claims 10 and 20**, Pintsov et al. further discloses wherein the information includes a return address of a sender of the at least one business reply mail piece and a request for additional materials, and wherein the method further comprises act of: identifying the request for additional materials; and in response to identifying the request, sending the additional materials to the sender (column 5, lines 21-37; column 6, lines 33-67; column 10, line 18, through column 11, line 20). Pintsov et al. fails to disclose using a mail processing facility as a fulfillment center. Gleckman discloses using a mail processing facility as a fulfillment center (paragraph [0013]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Pintsov et al. such that it uses a mail processing facility as a fulfillment center, as disclosed by Gleckman. Motivation is provided by Gleckman

Art Unit: 3628

in that doing so provides a service to organizations that wish to outsource such functions (paragraph [0013]).

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pintsov et al. in view of Connelly et al., U.S. Patent No. 6,459,953 B1.

As per **Claim 25**, Pintsov et al. further discloses wherein the sorting apparatus discards mail pieces (column 12, lines 36-52). Pintsov et al. fails to disclose wherein the at least one controller routes the at least one business reply mail piece to the at least one output bin that receives mail pieces. Connelly et al. discloses wherein the at least one controller routes the at least one business reply mail piece to the at least one output bin that receives mail pieces (column 3, line 57, through column 4, line 3). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Pintsov et al. such that the at least one controller routes the at least one business reply mail piece to the at least one output bin that receives mail pieces, as disclosed by Connelly et al. Motivation is provided by Connelly et al. in that routing of mail pieces to output bins allows for like mail pieces to be collected together for ease of removal (column 3, line 57, through column 4, line 3).

### ***Conclusion***

7. **Examiner's Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially

Art Unit: 3628

teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

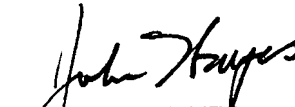
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Erb whose telephone number is (571) 272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nhe

Nathan Erb  
Examiner  
Art Unit 3628

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER